REMARKS

Claims 86-92 and 95-101 were pending in the present application. Claims 86-92 have been canceled without prejudice and claims 95 and 96 have been amended. The remarks made herein are designed to place the case in condition for allowance. As such, Applicants respectfully request that the remarks made herein be entered and fully considered.

The Rejection of Claims 86-92 under 35 U.S.C. §112, First Paragraph, Should Be Withdrawn

Claims 86-92 were rejected under 35 U.S.C. §112, first paragraph, "[a]s containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Specifically, the Examiner states that claim 86 encompasses antibodies that bind to epitopes not found in the particularly disclosed sequence.

Applicants respectfully traverse this rejection, however in the interest of expediting prosecution, and in no way acquiescing to the Examiner's rejection, Applicants have canceled claims 86-92, thereby rendering the rejection moot.

Therefore, Applicants respectfully request reconsideration and withdrawal of the foregoing 35 U.S.C. §112, first paragraph rejection.

The Rejection of Claims 86, 87, 89, 90, 95, 96, 98 and 99 under 35 U.S.C. §103(a), Should Be Withdrawn

Claims 86, 87, 89, 90, 95, 96, 98 and 99 remain rejected under 35 U.S.C §103(a), as being unpatentable over Nakagawa *et al.* (J. Lipid Res., 1995, 36:2212-2218) in view of Campbell, A. (Laboratory Techniques in Biochemistry And Molecular Biology, Volume 13, Chapter 1, pages 1-33, 1984) for the reasons of record set forth in the Office Action dated September 11, 2007.

As per the September 11, 2007 Office Action, the Examiner states "Nakagawa discloses a rat lysosomal acid lipase, which amino acid sequence (Figure 2) is about 54% identical to the present SEQ ID NO:417, and comprises amino acids 113-135 (23 residues) of the present SEQ ID NO:417 with 100% sequence identity. Nakagawa does not teach antibodies to the lipase." The Examiner then takes a quote from Campbell stating that it is "customary now for any group working on a macromolecule to both clone the genes coding for it and make monoclonal

antibodies to it (sometimes without a clear objective for their application)." The Examiner then concludes that "[i]t would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to make antibodies specific to Nakagawa's lipase"... and that such antibodies "[w]ould specifically bind to the polypeptide of the instant invention because they share the same sequence/epitope (23 amino acids)."

In response to Applicants' arguments to the September 11, 2007 Office Action, the Examiner states "[w]hile the examiner agrees that it would not have been obvious to one of skill in the art at the time of filing to select the 23 amino acids to make antibodies (such as monoclonal antibodies), the antibody pool generated using Nakagawa's rat lipase would encompass those specific to the epitopes of said 23 amino acids. The present claims, as written, do not exclude those antibodies, i.e., the claims encompass polyclonal antibodies (the "pool")."

Applicants respectfully traverse this rejection, however in an effort to expedite prosecution, and in no way acquiescing to the Examiner's rejection, Applicants have amended the claims as suggested by the Examiner. Specifically, Applicants have amended claim 95 to read "An isolated monoclonal antibody..." and claim 96 has been amended to delete polyclonal antibodies. Applicants believe that these amendments render the rejection moot and that the claimed antibodies would not have been obvious to one of skill in the art, at the time the claimed invention was made, despite the combination of Nakagawa *et al.* and Campbell. Reconsideration and withdrawal of the 35 U.S.C §103(a) rejection over claims 86, 87, 89, 90, 95, 96, 98 and 99 is respectfully requested.

The Rejection of Claims 88 and 97 under 35 U.S.C. §103(a), Should Be Withdrawn

Claims 88 and 97 remain rejected under 35 U.S.C §103(a), "[a]s being unpatentable over Nakagawa *et al.* (J. Lipid Res., 1995, 36:2212-2218), and in view of Campbell, A. (Laboratory Techniques in Biochemistry And Molecular Biology, Volume 13, Chapter 1, pages 1-33, 1984), as applied to claims 86, 87, 89, 90, 95, 96, 98 and 99 above, and further in view of Sandhu (Critical Reviews in Biotech, 1992, 12(5/6): 437-462, especially pages 449-450) for the reasons of record set forth in the last Office Action mailed on 11 September 2007, at pages 4-5." The Examiner combines Nakagawa and Campbell with Sandhu as Sandhu teaches Fab fragments of antibodies. Applicants respectfully traverse this rejection. For the reasons discussed above,

Applicants submit that the combination of Nakagawa *et al.* with Campbell with Sandhu does not render the claimed antibodies obvious to one of ordinary skill in the art. Reconsideration and withdrawal of the 35 U.S.C §103(a) rejection over claims 88 and 97 is respectfully requested.

The Rejection of Claims 91, 92, 100 and 101 under 35 U.S.C. §103(a), Should Be Withdrawn

Claims 91, 92, 100 and 101 remain rejected under 35 U.S.C §103(a), "[a]s being unpatentable over Nakagawa *et al.* (J. Lipid Res., 1995, 36:2212-2218), and in view of Campbell, A. (Laboratory Techniques in Biochemistry And Molecular Biology, Volume 13, Chapter 1, pages 1-33, 1984), as applied to claims 86, 87, 89, 90, 95, 96, 98 and 99 above, and further in view of Hermanus *et al.*, US 3,654,090 for the reasons of record set forth in the last Office Action mailed on 11 September 2007, at page 5." The Examiner combines Nakagawa and Campbell with Hermanus as "Hermanus teaches a method of making enzyme-labeled antibodies or antigens for the determination of antibodies or antigens." For the reasons discussed above, Applicants submit that the combination of Nakagawa *et al.* with Campbell and Hermanus does not render the claimed antibodies obvious to one of ordinary skill in the art. Reconsideration and withdrawal of the 35 U.S.C §103(a) rejection over claims 91, 92, 100 and 101 is respectfully requested.

CONCLUSIONS

In view of the amendments and remarks made herein, Applicants respectfully submit that the rejections presented by the Examiner are now overcome and that this application is in condition for allowance. If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned.

It is believed that this paper is being filed timely as a request for a three month extension of time is filed concurrently herewith. No additional extensions of time are required. In the event any additional extensions of time are necessary, the undersigned hereby authorizes the requisite fees to be charged to Deposit Account No. 501668.

Entry of the remarks made herein is respectfully requested.

Respectfully submitted,

November 6, 2008

MILLENNIUM PHARMACEUTICALS, INC.

By 

Mario Cloutier
Registration No. 57,225
40 Lansdowne Street
Cambridge, MA 02139
Telephone – (617) 577-3522
Facsimile – (617) 551-8820